

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed September 6, 2005. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Allowable Subject Matter

Applicant notes with appreciation the Examiner's allowance of Claims 47, 55, and 63. Applicant also notes with appreciation the Examiner's indication that the subject matter of Claims 8-9, 18-19, 28-29, 38-39, 45-46, 53-54, and 61-62 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (See Pending Office Action: page 5.) Applicant and the Examiner have made substantial progress in this case. Accordingly, Applicant is optimistic that after reviewing the following trenchant analysis, the Examiner will recognize why the remaining claims are allowable over the Prior Art.

Section 103 Rejections

The Examiner rejects Claims 1, 6-7, 10-11, 16-17, 20-21, 26-27, 30-31, 36-37, and 40 under 35 U.S.C. §103(a), as being unpatentable over U.S. Publication No. 2002/0037744 issued to Bhatia et al. (hereinafter "*Bhatia*") in view of U.S. Patent No. 6,584,190 issued to Bressler (hereinafter "*Bressler*"). The Examiner rejects Claims 2-4, 12-14, 22-24, 32-34, 41-44, 48-52, 56-60, and 64 under 35 U.S.C. §103(a), as being unpatentable over *Bhatia* and *Bressler* and further in view of U.S. Publication No. 2002/0065064 issued to Griffith et al. (hereinafter "*Griffith*"). These rejections are respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.<sup>1</sup>

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<sup>1</sup> See M.P.E.P. §2142-43.

The rejected claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation of the Independent Claims. For example, Independent Claim 1 recites “determining allowability of the session, through an out-of-band communication, based on a service agreement without accessing external resources, the out-of-band communication comprising discovery messages.”

There is nothing in *Bhatia* or *Bressler* that offers these out-of-band capabilities. Moreover, not a single reference discloses the use of discovery messages: much less discovery messages in out-of-band communications and, further, such signaling in the context of determining the allowability of a session. For all of these teachings, the Examiner relies on *Bhatia* and *Bressler*. Evaluating *Bhatia* first, Applicant has searched *Bhatia* in its entirety and cannot find any disclosure of out-of-band messages. The Examiner has cited several paragraphs of *Bhatia* in his Office Action for this subject matter, but this information is simply not there. In this regard, Applicant is bewildered. It is as if the Examiner has used necromancy to pull notional limitations from a Prior Art abyss. Assuredly, there are no latent teachings of *Bhatia*, as Applicant has studied this reference thoroughly. Accordingly, Applicant respectfully requests the Examiner to terminate his groundless reliance on this reference.

Turning to *Bressler*, *Bressler* merely provides an innocuous recitation of “out-of-band” messages. (See *Bressler*: Column 1, lines 21-24.) But a mere recitation of out-of-band messages does not provide the proper support for the Examiner’s §103 rejection. *Bressler* offers an architecture for communications of telephony control signaling over data networks, but offers nothing that is relevant to service agreements, determining an allowability of the session, etc. Furthermore, there is nothing in any other reference that provides this missing disclosure (i.e. out-of-band signaling with use of discovery messages in the environment of session allowability). Because the references lack such limitations, Independent Claim 1 is clearly allowable over the proposed combinations for at least these reasons.

Independent Claims 11, 21, 31, 41, 49, and 57 recite limitations similar, but not identical, to those recited in Independent Claim 1. Therefore, these claims are also allowable, for example, for the same reasons as identified above. Additionally, the corresponding

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dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

Accordingly, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant submits herewith a check in the amount of \$790.00 to satisfy the request for continued examination fee of 37 C.F.R. §1.17(e). If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas J. Frame, at (214) 953-6675.

Respectfully submitted,  
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